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09/710,842	11/14/2000	Martin Cipar		6149

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Mark I Bowditch
Rolthwell Figg Ernst & Manbeck
Suite 701-East 555 13th Street N W
Washington, DC 20004

EXAMINER

GRUNBERG, ANNE MARIE

ART UNIT

PAPER NUMBER

1661

DATE MAILED: 04/03/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/710,842

Applicant(s)

Martin Cipar

Examiner

Anne Marie Grunberg

Art Unit

1661



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on Nov 14, 2000

2a) ☐ This action is FINAL.

2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) 1-18 is/are pending in the application.

4a) Of the above, claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) 1-18 is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

9) ☒ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) ☐ All b) ☐ Some* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. _____

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

15) ☒ Notice of References Cited (PTO-892)

16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____

18) ☒ Interview Summary (PTO-413) Paper No(s). 3

19) ☐ Notice of Informal Patent Application (PTO-152)

20) ☐ Other:

Art Unit: 1661

DETAILED ACTION

The Group and/or Art Unit location of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Group Art Unit 1661.

~~The specification is objected to because on page 12, line 3, a blank line exists after "at".~~
Correction is required. No new matter may be added.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claim 1 and dependent claims 2-18 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The invention employs the potato cultivar designated "FL1879". Since the plants are essential to the claimed invention they must be obtainable by a repeatable method set forth in the specification or otherwise be known and readily available to the public. If the plants are not so obtainable or available, the requirements of 35 USC 112 may be satisfied by a deposit of the

Art Unit: 1661

plants. It is noted in the Deposit Information in the specification, that upon allowance, applicant will deposit 25 vials of tissue culture material with the American Type Culture Collection of the potato cultivar FL1879. A deposit of 25 vials of each of the claimed embodiments is considered sufficient to ensure public availability. It is also noted that applicant states that access to this deposit will be available during the pendency of this application to persons determined by the ~~Commissioner of Patents and Trademarks to be entitled thereto under 37 CFR 1.14 and 35 USC~~ 122, and upon allowance of any claims, all restrictions on the availability to the public of the variety will be irrevocably removed. However, there is no indication in the specification as to whether the deposit will be made under the terms of the Budapest Treaty, nor have all of the requirements been stated that would satisfy the deposit requirement made herein.

If the deposit is made under the terms of the Budapest Treaty, then an affidavit or declaration by applicants, or a statement by an attorney of record over his or her signature and registration number, stating that the specific strain has been deposited under the Budapest Treaty and that the strain will be irrevocably and without restriction or condition released to the public upon the issuance of a patent, would satisfy the deposit requirement made herein.

If the deposit is not made under the Budapest Treaty, then in order to certify that the deposit meets the criteria set forth in 37 C.F.R. 1.801-1.809, applicants may provide assurance of compliance by an affidavit or declaration, or by a statement by an attorney of record over his or her signature and registration number, showing that

Art Unit: 1661

- (a) during the pendency of this application, access to the invention will be afforded to the Commissioner upon request;
- (b) all restrictions upon availability to the public will be irrevocably removed upon granting of the patent;
- (c) the deposit will be maintained in a public depository for a period of 30 years or 5 years after the last request or for the effective life of the patent, whichever is longer;
- (d) a test of the viability of the biological material at the time of deposit (see 37

CFR 1.807); and,

- (e) the deposit will be replaced if it should ever become inviable.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-2, 5, 7, 9-11, 13, 17, and dependent claims 3-4, 6, 8, 12, 14-16, and 18, are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 2, 9, 13, and 17, and dependent claims 3-7, 10-12, 14-16, and 18, are rejected under 35 USC 112, second paragraph, as being indefinite for the terminology "plant and its

Art Unit: 1661

parts". Since a plant always includes its parts, it is not clear what further limitation is added by "and its parts".

Claim 1 and dependent claims 2-18 are rejected under 35 USC 112, second paragraph, as being indefinite in the recitation of "FL1879" which is a name designation and is subject to change. Amendment of the claim to refer to the deposit accession number of the claimed tuber would obviate this objection. Alternatively, applicant may reword the claim in the following manner: --A potato tuber designated FL1879, wherein a sample of regenerable cells has been deposited under ATCC Accession No._____.-- The applicant will then need to amend the claim upon allowance to reflect the accession number.

Claim 5 is vague and indefinite in the recitation "having the physiological and morphological characteristics" because it is not clear which physiological and morphological characteristics are intended. Thus the claim language fails to clearly set forth the metes and bounds of the claimed invention. Amendment of the claim to insert --all-- after "having" would obviate this rejection.

Claim 11 recites the limitation "said....parent" in line 3. There is insufficient antecedent basis for this limitation in the claim.

Art Unit: 1661

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

~~6. Claim 5 is rejected under 35 U.S.C. 102(b) as being anticipated by Cipar.~~

Claim 5 is drawn to a potato plant having the physiological and morphological characteristics of FL1879.

This claim reads on potato genotypes *per se* since it does not specify the physiological and morphological characteristics of interest. As a result, any genotype that has as much as one gene in common with the instant cultivar constitutes prior art.

Cipar teaches a potato variety having white flowers (abstract).

Amendment of these claims as previously indicated would obviate this rejection.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 1661

8. Claims 7 and 10 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Cipar.

Claims 7 and 10 are drawn to a plant regenerated from cultured cells of FL1879.

Cipar teach a potato cultivar that has moderately green foliage, vigorous vine growth and white flowers, and a relatively high specific gravity (abstract). In claim 5, Cipar teaches a potato plant regenerated from tissue culture.

However, claims 7 and 10 do not state characteristics of the resultant plant, and somaclonal variation could occur during tissue culture which would make a plant regenerated from cultured FL1879 cells indistinguishable from any potato plant, such as the prior art plants, despite their being made by an alternative process. See In re Thorpe, 227 USPQ 964,966 (Fed. Cir. 1985), which teaches that a product-by-process claim may be properly rejectable over prior art teaching the same product produced by a different process, if the process of making the product fails to distinguish the two products. Thus, the claimed invention was clearly prima facie obvious as a whole to one of ordinary skill in the art, if not anticipated by Cipar.

Amendment of the claims by inserting -- , said plant having all the physiological and morphological characteristics of the plant of claim 2[9] -- at the end of the claims would obviate the rejection.

Art Unit: 1661


Claims 1-4, 6, 8-9 and 11-18, are deemed free of the prior art, given the failure of the prior art to teach or suggest a potato plant having all of the physiological and morphological characteristics and exact genotype as the exemplified variety.

No claim is allowed.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anne Marie Grunberg whose telephone number is (703) 305-0805. The examiner can normally be reached Monday through Friday from 8:00 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bruce Campell, can be reached on (703) 308-4205. The fax phone number for this group is (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.


BRUCE R. CAMPPELL, PH.D.
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600

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